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10/758,262	01/16/2004	Kevin Sullivan	JPC-011 D1	5705

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EXAMINER	
LIVERSEDGE, JENNIFER L	
ART UNIT	PAPER NUMBER
3692	

NOTIFICATION DATE	DELIVERY MODE
06/24/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/758,262	SULLIVAN, KEVIN	
	Examiner	Art Unit	
	JENNIFER LIVERSEDGE	3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 April 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *37,40-45,47-50,54 and 55* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *37,40-45,47-50,54 and 55* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

This Office Action is responsive to Applicant's amendment and request for continued examination of Application 10/758,262 filed on April 30, 2009.

The amendment contains previously presented claims: 40-43, 45 and 47-50.

The amendment contains amended claims: 37 and 44.

The amendment contains new claims: 54-55.

Claims 1-36, 38-39, 46 and 51-53 have been canceled.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 30, 2009 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 55 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. It is unclear as to whether this claim in meant to be a part of the claim set or if it was inadvertently inserted and left incomplete.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 37, 40-45, 47-50 and 54-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,070,153 to Simpson (further referred to as Simpson), in view of Ogilvie (further referred to as Ogilvie), in view of US Patent 6,345,261 B1 to Feidelson et al. (further referred to as Feidelson), and further in view of US Patent 5,940,811 to Norris (further referred to as Norris).

Regarding claim 37, Simpson discloses a computerized method for implementation of multiple accounts, wherein the multiple accounts include at least one card payment instrument account from a card issuer and at least one investment account from a financial institution (columns 1-6), the method comprising:

Providing a card and investment application to an applicant, the card and investment applications entitling an approved cardholder to establish a card payment instrument account and an investment account (column 2, lines 32-49; column 3, line 50 – column 4, line 67);

Approving a submitted card and investment application through an application processor system including one or more computer processors and maintained by the card issuer (column 3, line 55 - column 4, line 37);

Establishing the card payment instrument account through the application processor system maintained by the card issuer for the approved cardholder upon acceptance, wherein the card payment instrument account includes a reward feature available to the cardholder (Figures 1 and 3; column 1, lines 10-25 and lines 45-63; column 2, lines 30-39; column 3, line 50-column 4, line 53; column 5, lines 25-28; column 6, lines 19-26);

Automatically creating the investment account for the approved cardholder through the financial institution, creation of the investment account triggered upon approval of the submitted card and investment applications (Figure 1; column 2, lines 30-39; column 3, line 50-column 4, line 53; column 6, lines 19-26);

Linking, using the application processor system, the card payment instrument account from the card issuer to the investment account from the financial institution in an account maintained by the card issuer (Figure 1; column 2, lines 30-41; column 4, lines 27-37; column 6, lines 19-27);

Issuing a card payment instrument linked to the multiple accounts (column 3, lines 50-60; column 4, lines 10-18);

Establishing a reward structure through an agreement between the financial institution and the card issuer (column 1, lines 46-63; column 2, lines 9-11; column 5, lines 25-30);

Implementing the reward feature, using a rewards processing system maintained by the card issuer, by tracking expenditures made through the card payment instrument account and calculating a monetary reward amount based on the tracked expenditures (Figure 3; column 1, lines 10-25 and lines 45-63; column 4, lines 45-53; column 5, lines 25-28);

Depositing the monetary reward amount generated by the rewards processing system into the investment account at a predetermined time interval using a reward issue and transfer system (Figure 3; column 1, lines 45-63); and

Allowing independent funding of the investment account by the cardholder (Figures 1 and 3; column 1, lines 54-67; column 2, lines 17-22; column 4, lines 13-19; column 4, line 63-column 5, line 5; column 5, lines 41-59).

Simpson does not disclose an investment fund card application enabling establishment of a card and an investment account. However, Ogilvie discloses where

one application is used to both apply for and establish a credit card and an investment vehicle based on the card use, wherein a single application is filled out for both the credit card and for designating a reward selection (column 1, lines 56-67). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the simultaneous accepting of credit card and investment fund account applications for the establishment of linked accounts as disclosed by Simpson to adapt the use of a single form for both accounts as disclosed by Ogilvie. The motivation would be that both accounts are set up using an individual’s personal data and information, and establishing both accounts based on this one-time receipt of data enables an efficient and less error prone mechanism for opening linked accounts.

Neither Simpson nor Ogilvie disclose wherein the issued card payment instrument bears the name of the financial institution and the name of the card issuer. However, Feidelson discloses wherein the issued card payment instrument bears the name of the financial institution and the name of the card issuer (column 14, lines 38-42). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the use of a credit card wherein a reward feature is implemented through partnership with another organization using a single application as disclosed by Simpson and Ogilvie to adapt issuing a credit card that bears partnership organizations on the card as disclosed by Feidelson. The motivation would be that co-branding a credit card by including the names of participating organizations on the card, rather than just one organization in the partnership, builds customer use in using the card by providing visual queues as to the benefit of the using the card. When a user is

preparing to pay for a purchase and opens their wallet and sees, for example, three credit cards, the credit card with a visual reminder that using that card will result in a deposit into one's investment account based on the purchase value will inspire the purchaser to select that card for the purchase over a card which offers no specific and tangible reward. Building loyalty and encouraging use is the motivation behind the use of co-branded credit cards.

Neither Simpson, Ogilvie nor Feidelson disclose consulting a credit bureau database prior to approving the investment fund card application. However, Norris discloses consulting a credit bureau database prior to approving a card application. Given the combination of Simpson, Ogilvie and Feidelson above, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the reviewing of an application for a linked credit and investment account as disclosed by the combination to adapt the obtaining of a credit report to make a determination to grant or deny the application as disclosed by Norris, the motivation being that it is considered standard business practice to perform a credit check on an individual or entity prior to issuing credit.

Regarding claim 44, Simpson discloses a computerized method for establishing and implementing multiple accounts, wherein the multiple accounts include at least one card payment instrument account from a card issuer and at least one investment account from a financial institution (columns 1-6), the method comprising:

Simultaneously offering multiple accounts including the card payment instrument account through the card issuer and the investment account from the financial institution (column 2, lines 30-38; column 3 line 50-column 4, line 53; column 6, lines 19-26);

When a recipient of an offer for multiple accounts accepts the offer for multiple accounts, establishing using an application processor system of a card issuer computing system, the card payment instrument account in response to the acceptance, wherein the card payment instrument account includes a reward feature available to the recipient (Figures 1 and 3; column 1, lines 10-25 and lines 45-63; column 2, lines 30-39; column 3, line 50-column 4, line 53; column 5, lines 25-28; column 6, lines 19-26);

Automatically creating the investment account after the acceptance of the offer for multiple accounts upon notification provided to the financial institution to create the investment account and upon establishment of the card payment instrument account by the application processor system (Figure 1; column 2, lines 30-39; column 3, line 50-column 4, line 53; column 6, lines 19-26);

Issuing a card payment instrument linked to the multiple accounts (column 3, lines 50-60; column 4, lines 10-18);

Establishing a reward structure through an agreement between the financial institution and the card issuer (column 1, lines 46-63; column 2, lines 9-11; column 5, lines 25-30);

Implementing the reward feature by tracking expenditures made through the card payment instrument account and calculating, using a reward processing system including at least one computer processor, a monetary reward amount based on the

tracked expenditures (Figure 3; column 1, lines 10-25 and lines 45-63; column 4, lines 45-53; column 5, lines 25-28);

Transferring the monetary reward amount generated by the reward feature to the investment account at predetermined time intervals (Figure 3; column 1, lines 45-63).

Simpson does not disclose an investment fund card application enabling establishment of a card and an investment account. However, Ogilvie discloses where one application is used to both apply for and establish a credit card and an investment vehicle based on the card use, wherein a single application is filled out for both the credit card and for designating a reward selection (column 1, lines 56-67). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the simultaneous accepting of credit card and investment fund account applications for the establishment of linked accounts as disclosed by Simpson to adapt the use of a single form for both accounts as disclosed by Ogilvie. The motivation would be that both accounts are set up using an individual's personal data and information, and establishing both accounts based on this one-time receipt of data enables an efficient and less error prone mechanism for opening linked accounts.

Simpson does not disclose selecting, using a reward issue and transfer system operated by the card issuer, a transfer destination for the reward, wherein the transfer destination is selected from the established investment account and an alternative destination. However, Ogilvie discloses using a reward issue and transfer system operated by the card issuer, a transfer destination for the reward, wherein the transfer destination is selected from the established investment account and an alternative

destination (column 3, lines 1-16 and lines 55-59). Given the combination of Simpson and Ogilvie above, it would be further obvious to modify the credit card and investment linked accounts as disclosed by Simpson to adapt the provision of more than one investment account into which a funds transfer may be designated. The motivation would be to provide the reward earner greater flexibility in receiving rewards wherein the reward earner may stipulate certain awards into a savings account and certain awards into checking, etc.

Neither Simpson nor Ogilvie disclose wherein the issued card payment instrument bears the name of the financial institution and the name of the card issuer. However, Feidelson discloses wherein the issued card payment instrument bears the name of the financial institution and the name of the card issuer (column 14, lines 38-42). It would be obvious to one of ordinary skill in the art at the time of the invention to modify the use of a credit card wherein a reward feature is implemented through partnership with another organization through a single application as disclosed by Simpson to adapt issuing a credit card that bears partnership organizations on the card as disclosed by Feidelson. The motivation would be that co-branding a credit card by including the names of participating organizations on the card, rather than just one organization in the partnership, builds customer use in using the card by providing visual queues as to the benefit of the using the card. When a user is preparing to pay for a purchase and opens their wallet and sees, for example, three credit cards, the credit card with a visual reminder that using that card will result in a deposit into one's investment account based on the purchase value will inspire the purchaser to select that

card for the purchase over a card which offers no specific and tangible reward. Building loyalty and encouraging use is the motivation behind the use of co-branded credit cards.

Regarding claim 45, Simpson discloses allowing independent funding of the investment account by the cardholder (Figures 1 and 3; column 1, lines 54-67; column 2, lines 17-22; column 4, lines 13-19; column 4, line 63-column 5, line 5; column 5, lines 41-59).

Regarding claims 40 and 47, Simpson discloses wherein the card payment instrument account includes at least one of a credit card account, a stored value card account, a debit card account, and a multi-featured credit on a debit card account (column 1, lines 21-25 and 45-53; column 2, lines 29-49).

Regarding claims 41 and 48, Simpson discloses wherein the investment account includes at least one of a mutual fund account, a stock account, an individual retirement account, a 401(k) plan account, a savings account, a certificate of deposit account, a money market fund, and an employee stock purchase account (column 1, lines 21-25 and 45-53).

Regarding claims 42 and 49, Simpson discloses calculating the monetary reward amount each month as a percentage of net purchases in the card payment instrument

account (column 1, lines 54-59; column 2, lines 50-66; column 4, lines 45-57; column 5, lines 25-30).

Regarding claims 43 and 50, Simpson discloses transferring the monetary reward amount to the investment account at least once a year (column 1, lines 54-59; column 2, lines 50-66; column 4, lines 45-57; column 5, lines 25-30).

Regarding claims 54 and 55, Simpson does not disclose where the alternative destination is an additional account maintained by the cardholder. However, Ogilvie discloses where the alternative destination is an additional account maintained by the cardholder (column 3, lines 1-16 and lines 55-59). Given the combination of Simpson and Ogilvie above, it would be further obvious to modify the rewards being paid to a credit card user as disclosed by Simpson to adapt the rewards being transferred into alternative accounts maintained by the cardholder as disclosed by Ogilvie, the motivation being that the cardholder has earned the rewards and having the flexibility to direct the reward funds into multiple user accounts makes the reward more attractive to the cardholder with more discretion as to where the funds are deposited.

Response to Arguments

Applicant argues that Simpson fails to disclose an investment fund card application and that the section of Ogilvie relied upon to teach this feature (that of a single application through which one can apply for a credit card and an investment

account) fails to disclose where the credit card issuer and the account holder into which consumer funds are deposited are operated by the same institution. Applicant argues that the prior art would need to teach a single application for services through two different entities rather than through the same entities. However, upon review of the claims, there is not a requirement as set forth in the claims that the entities issuing the credit card and holding the investment account are required to be separate. The claims do recite a card issuer and a financial institution which holds an account, but nothing in the claim makes a recitation that the issuer and the account holding institution are necessarily separate entities.

Despite this distinction, and to further aid in the prosecution of the application, examiner points to prior art disclosed in Business Wire titled "LoanWise.com changes name to LiveCapitol and raises $40 million". In this article, it is stated that using this on-line service, an individual can complete one application and in return receive offers for loans, credit cards and leases from multiple lenders. Hence, a single application is submitted and from that, multiple service providers are contacted and the user then receives offers from the multiple lenders.

Additionally on this point, Feidelson at column 14, lines 34-44 disclose that a single registration form is submitted by which a user is signed up for an investment account and a credit card. Feidelson does disclose that the one form includes a credit application, but it is none the less one form that is submitted with various contents therein.

The Ogilvie reference, as used in the rejection above, discloses the use of a single application which can be used to open a credit card account and an investment account. While the Principal Bank VISA in this case operates both the credit card account and the investment account, there is no reason that the single application couldn't be used across multiple institutions as disclosed by Business Wire. Ogilvie discloses in multiple locations that the card issuer and the investment account can be with different entities and does not indicate that multiple applications are being submitted. Rather, Ogilvie indicates that a agreement is in place between the individual and the card issuer and that from there funds can be directed into an investment account (column 6, lines 8-24).

Applicant further argues that none of the references teach a credit card bearing two names, those of the issuer and the financial institution. Both Simpson and Ogilvie disclose the partnering of a card issuer and a financial institution in offering a rewards program in which consumers can invest funds based on transactions using credit cards. Likewise, Feidelson discloses such a system. Additionally, as presented in the Office Action above, Feidelson also specifically discloses where a co-branded credit card between the administrator and a credit card issuer. It is disclosed at column 5, lines 31-37 and column 6, lines 33-42 that the administrator is a broker/dealer associated with an investment fund. Therefore, Feidelson discloses a co-branded card between the card issuer and the financial institution (the broker/dealer managing the investment fund).

Applicant argues that the prior art fails to disclose creating the investment account in response to the acceptance when the card issuer notifies the financial institution to open an investment account upon approval and establishment of the card payment instrument account. However, examiner points to various sections in Simpson in which an investment account is opened upon approval of the card payment instrument account, and as discussed above, the credit card issuer and financial institution are separate entities maintaining separate and distinct accounts. As noted particularly at column 3, line 50 – column 4, line 5, the credit card account is first created, and then an investment account is created. Given that Simpson discloses that the investment account and credit account may be held or serviced or different entities or the same entity, it would be obvious that if the accounts were managed by different entities, that the credit card account would be created by the credit card issuer and then the investment account would be created by the financial institution managing the investment account, per the steps at column 3, line 50 – column 4, line 5.

Applicant also argues that the prior art fails to disclose "creating the investment account in response to the acceptance when the card issuer notifies that financial institution to create the investment account upon establishment of the card payment instrument account by the card issuer". However, this limitation is not found within the claims. The claims as amended indicate that the investment account is created upon approval of the submitted investment fund card application. Given the rejection and arguments as set forth above with regards to a single application resulting in multiple

account openings, examiner notes that once the single application is approved, then both the credit card and the investment fund are set up or opened.

The Courts have stated that "[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." KSR Int'l Co. v. Teleflex, Inc. 127 S. Ct. 1727, 1740, 92 USPQ2d 1385, 1396 (2007).

In the instant case, the cited prior art references were available in the field at the time of the purported invention. The Applicant merely implemented a predictable variation of these existing methods in establishing his/her own invention. Such predicatability is based upon the fact that each incorporated method performs the same function and provides the same utility as originally intended in their pre-combination state.

Conclusion

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached at 571-272-6702. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jennifer Liversedge/
Examiner, Art Unit 3692